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ART UNIT	PAPER NUMBER
2137	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/756,896	JASCAU ET AL.
	Examiner	**Art Unit**	
	Minh Dieu Nguyen	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2007*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,7-13,17-24 and 27-30* is/are pending in the application.

    4a) Of the above claim(s) *4-6,14-16,25 and 26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,7-13,17-24 and 27-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This office action is in response to the communication dated 10/12/2007 with the amendment to claims 1-2, 7, 9-13, 17, 21-24 and 27-30 and the cancellation of claims 4-6, 14-16 and 25-26.

2.   Claims 1-3, 7-13, 17-24 and 27-30 are pending.

Response to Arguments

3.   Applicant's arguments with respect to claims 1-3, 7-13, 17-24 and 27-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4.   Claims 21-24 and 27-30 are objected to because of the following informalities:

The phrase "computer-readable medium" should be "computer-readable **storage** medium" (according to the specification).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   The rejections of claims 1-30 have been withdrawn based on the filed amendment.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7.   Claims 11-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a)   As to claim 11, this claim is directed to a device comprising a determining module and a converting module. According to the specification (i.e. paragraphs 0023, 0040), these modules are program instruction, at best these modules are functional descriptive material per se. As such, it is non-statutory.

b)   As to claims 12-20, these claims depend on claim 11 and are rejected by a similar rationale applied against claim 11.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.   Claims 1, 3, 7, 9-11, 13, 17, 19-21, 23-24, 27 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Sigbjornsen et al. (6,266,416).

a)   As to claim 1, Sigbjornsen discloses a method of copy protecting a program to be installed on a computer system, said computer system including a

computing section and a copy protection unit (i.e. workstation-PC and smart card,

Sigbjornsen: Fig. 1), said method comprising:

determining a decision section of the program, which decision section, during

execution of the program as a function of a current running state of the program, defines

information influencing further course of the program (Sigbjornsen: col. 5, line 66 – col.

6, line 8); and

converting the decision section of the program to produce a copy-protected

version of the program (i.e. encrypting by means of an encryption function g,

Sigbjornsen: col. 6, lines 30-34), wherein converting comprises:

providing code in the copy-protected version of the program, wherein said

code is executable exclusively in the copy protection unit and exclusively during

execution of the copy-protected version of the program in the computing section,

and wherein said code includes data and a processing regulation applicable to

the data for execution of the decision section of the program; and

providing a program instruction in the copy-protected version of the

program, the program instruction being configured such that, during execution of

the copy-protected version of the program in the computing section, the copy

protection unit is called and the code is transferred to the copy protection unit for

execution therein (i.e. when program executes, program calls with encrypted

parameter are conveyed to the smart card, the values are calculated in the smart

card and returned back to the program, Sigbjornsen: col. 6, line 34 to col. 7, line

24).

b)   As to claims 11, 21 and 24, these claims are directed to hardware and software implementation of the method of claim 1 and are rejected by a similar rationale applied against claim 1.

c)   As to claim 3, Sigbjornsen discloses the method of claim 1, wherein said information comprises a program address at which execution of the program is resumed (i.e. call sequence and program calls are disclosed, inherently understood that program address is provided so after the call sequence is finished, the main program knows where to resume, Sigbjornsen: col. 4, lines 14-32).

d)   As to claims 13 and 23, these claims are directed to hardware and software implementation of the method of claim 3 and are rejected by a similar rationale applied against claim 3.

k)   As to claim 7, Sigbjornsen discloses the method of claim 1, wherein the data required for execution of the decision section and the processing regulation are encoded and are transferred to the copy protection unit in encoded form (Sigbjornsen: col. 6, lines 9-14 and 32-34).

l)   As to claims 17 and 27, these claims are directed to hardware and software implementation of the method of claim 7 and are rejected by a similar rationale applied against claim 7.

m)   As to claim 9, Sigbjornsen discloses the method of claim 1, wherein the step of determining a decision section of the program further comprises determining the decision section according to an instruction sequence of the decision section in the program (Sigbjornsen: col. 6, lines 6-8).

n   As to claims 19 and 29, these claims are directed to hardware and

software implementation of the method of claim 9 and are rejected by a similar rationale

applied against claim 9.

o)   As to claim 10, Sigbjornsen discloses the method of claim 1, further

comprising repeating the steps of determining a decision section of the program and

converting the decision section to determine and convert a plurality of decision sections,

wherein if two similar decision sections are determined, the similar decision sections are

converted by different codes in the converting steps (i.e. the way the program is

structured allowing program calls are executed differently by different key and algorithm,

Sigbjornsen: col. 7, lines 29-67).

p)   As to claims 20 and 30, these claims are directed to hardware and

software implementation of the method of claim 10 and are rejected by a similar

rationale applied against claim 10.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 2, 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Sigbjornsen et al. (6,266,416) in view of Mu et al. (5,343,524).

Sigbjornsen discloses the method of claim 1, however Sigbjornsen is silent on the capability of having said code effects a comparison of two data values and a definition of the information of result of said comparison when the code is executed.

Mu is relied on for the teaching of having said code effects a comparison of two data values and a definition of the information of result of said comparison when the code is executed (i.e. the intelligent security device (ISD) contains a microprocessor, attached to a serial port. This device contains some of the software needed to operate the program. The software in the device is encrypted, so that, if copied, it will not function. The program running in the computer system to which the device is attached sends a security code to the device. The device decrypts its internal software needed to interpret the security code, and decrypts a security code within the hardware device and compares the two codes with the internal software. If everything matches, the device returns some software to the computer system. This software is inserted into the program, which enables operation of the program, see Mu: col. 10, lines 25-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having said code effects a comparison of two data values and a definition of the information of result of said comparison when the code is executed in the system of Sigbjornsen, as Mu teaches so as to protect proprietary software against unauthorized usage (Mu: col. 1, lines 5-15).

12.   Claims 8, 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sigbjornsen et al. (6,266,416) in view of Glover (6,052,780).

a)   As to claim 8, Sigbjornsen discloses the method of claim 1, however it is silent on the capability of having the code in the copy protection unit is executed in a protected area of the computer system, wherein the protected area is closed to the rest of the computer system. Glover is relied on for the teaching of having the code in the copy protection unit is executed in a protected area of the computer system, wherein the protected area is closed to the rest of the computer system (Glover: col. 3, lines 62-66). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of the code in the copy protection unit is executed in a protected area of the computer system, wherein the protected area is closed to the rest of the computer system in the system of Sigbjornsen, as Glover teaches so as to secure the data (Glover: col. 3, lines 55-56).

b)   As to claims 18 and 28, these claims are directed to hardware and software implementation of the method of claim 8 and are rejected by a similar rationale applied against claim 8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

MinhDieu Nguyen
Patent Examiner
1/7/08